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10/536,840

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT

PAPER NUMBER

2627

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/536,840 | Applicant(s) HENDRIKS ET AL. | |
| | Examiner Peter Agustin | Art Unit 2627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 5 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is a national stage entry (371) of PCT/IB03/05376, filed November 24, 2003.
2. Claims 1-10 are currently pending.

Election/Restrictions

3. Applicant's election of species (a) of Figures 1a & 1b and claims 1-3 & 5-9 in the reply filed on June 4, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 4 & 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 4, 2008.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

7. The references US 6,124,988 & EP 0865037 cited in the Search Report PCT/IB03/05376, issued May 18, 2004 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

Specification

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Yamakawa et al. (US 5,737,294).

In regard to claim 5, Yamakawa et al. disclose an objective lens (Figure 3, element 8) comprising at least an annular part (8b) having a first numerical aperture and a central part (8a) having a second numerical aperture, wherein the second numerical aperture is higher than the first numerical aperture (patent claim 4: “wherein said first region formed in a central portion of

said lens has a higher numerical aperture than said second region formed in a peripheral portion of said lens”).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa et al.

For a description of Yamakawa et al., see the rejection above. However, Yamakawa et al. do not disclose: in regard to claim 7, that the second numerical aperture is higher than 0.7 and the first numerical aperture is more than ten per cent lower than the first numerical aperture; in regard to claim 8, that the first numerical aperture is between 0.35 and 0.7 and the second numerical aperture is higher than 0.7; and in regard to claim 9, that the first numerical aperture is between 0.35 and 0.7 and the second numerical aperture is higher than 0.8.

In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In this case, Yamakawa et al. disclose a general condition wherein a second numerical aperture of a central part of a lens is greater than a first numerical aperture of an annular part of the lens. Therefore, the specific values/ranges claimed in claims 7-9 would have been an obvious matter of engineering design choice and optimization

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which would have been discoverable by routine experimentation by one of ordinary skill in the art at the time of invention.

Allowable Subject Matter

13. Claims 1-3 are allowed over the prior art of record.
14. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record alone or in combination fails to teach or suggest:

in claim 1, an optical scanning device for scanning at least a first type of information carrier having a first information layer and a first transparent layer of a first thickness and a second type of information carrier having a second information layer and a second transparent layer of a second thickness greater than the first thickness, said optical scanning device comprising means for generating at least a first and a second radiation beam, and an objective lens comprising at least an annular part having a first numerical aperture and a central part having a second numerical aperture higher than the first numerical aperture, wherein the first information layer is intended to be scanned by the first radiation beam through the central part of the objective lens and the first transparent layer, and the second information layer is intended to be scanned by the second radiation beam through the annular part of the objective lens and the second transparent layer; and

in claim 6, said lens comprising an optical axis and a cavity located around said optical axis, said cavity having a substantially cylindrical shape, the bottom of said cavity forming the central part of the objective lens.

Claims 2 & 3 are dependent upon claim 1.

Conclusion

16. The prior art made of record and not relied upon (see attached PTO-892) is considered pertinent to applicant's disclosure of an optical scanning device used for two types of information carriers having different thicknesses, and/or an objective lens comprising two areas having different numerical apertures.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Agustin whose telephone number is (571) 272-7567. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Vincent Agustin/
Patent Examiner, Art Unit 2627